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EXAMINER

CARTER, KENDRA D

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1617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/007,869	Applicant(s) GRANGER ET AL.	
	Examiner Kendra D. Carter	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on August 21, 2007 has been entered.

The Examiner acknowledges the applicant's remarks and arguments of August 21, 2007 made to the office action filed March 21, 2007. Claims 1, 2, 4-7, 9-12 and 14-18 are pending. Claims 1, 6, and 11 are amended.

The Applicant's arguments of the 35 U.S.C. 112, first paragraph rejection of claims 1-2, 4-7, 9-12 and 14-18 were found persuasive, and thus withdrawn.

For the reasons in the previous office action and below, the Applicant's arguments of the 35 U.S.C. 103(a) rejection of claims 1-2, 4-7, 9-12, 14-5 and 17 as being unpatentable over U.S. Patent No. 5,914,116 to Soares et al, issued June 22,

1999, in view of U.S Patent No. 5,965,518 to Nakatsu et al, published October 12, 1999, and further in view of U.S. Patent No. 5,976,555 to Liu et al, issued November 2, 1999, were found not persuasive, thus the rejection is upheld.

For the reasons in the previous office action and below, the Applicant's arguments of the 35 U.S.C. 103(a) rejection of claim 18 as being unpatentable over U.S. Patent No. 5,914,116 to Soares et al, issued June 22, 1999, in view of U.S Patent No. 5,965,518 to Nakatsu et al, published October 12, 1999, and further in view of U.S. Patent No. 5,976,555 to Liu et al, issued November 2, 1999 as applied to claims 1-2, 4-7, 9-12, 14-5 and 17 above, and further in view of JP 04183797 to Kobayashi et al, published June 30, 1992, were found not persuasive, thus the rejection is upheld.

For the reasons in the previous office action and below, the Applicant's arguments of the 35 U.S.C. 103(a) rejection of claim 16 as being unpatentable over U.S. Patent No. 5,914,116 to Soares et al, issued June 22, 1999, in view of U.S Patent No. 5,965,518 to Nakatsu et al, published October 12, 1999, and further in view of U.S. Patent No. 5,976,555 to Liu et al, issued November 2, 1999 as applied to claims 1-2, 4-7, 9-12, 14-5 and 17 above, and further in view of JP 04183797 to Kobayashi et al, published June 30, 1992, and U.S. Patent No. 5,582,832 to Pillai et al, issued December 10, 1996, were found not persuasive, thus the rejection is upheld.

Due to the amendment to the claims, the modified 35 U.S.C. 103(a) rejections are made below.

The Applicant's arguments are addressed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(1) Claims 1-2, 4-7, 9-12, 14-5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,914,116 to Soares et al, issued June 22, 1999, in view of U.S Patent No. 5,965,518 to Nakatsu et al, published October 12, 1999, and further in view of U.S. Patent No. 5,976,555 to Liu et al, issued November 2, 1999.

Soares et al. teaches a method for a skin treatment regime and product that includes a first composition containing at least one active and functioning to impart a first benefit to skin, and a second composition that includes a second different active and imparts a second benefit to skin (see abstract, in particular.) Soares et al. teaches that the first and second compositions are stored in respective separate containers,

which are joined together (see abstract and column 2, lines 1-14, in particular.) Soares et al. teaches that the two compositions are kept separate because single formulations often compromise the performance of the severally combined actives (i.e. dual compartment package; see column 1, lines 15-25, in particular.) Thus, Soares et al. teaches providing a first composition in a first compartment, and a second composition in a second compartment, where the compositions in each respective containers are isolated from one another, and where the first and second compartments are joined together, as recited in claim 1.

With regards to the types of compositions provided, Soares et al. provides examples of first compositions and second compositions where the first composition is a cleanser and the second composition is an anti-acne preparation (see Table I, second entry, in particular), and also where the first composition is a sunscreen and the second composition is an anti-wrinkle cream (see Table I, tenth entry, in particular.) Soares et al. teaches that anti-wrinkle compositions and anti-acne preparations can contain actives such as retinoids, where suitable retinoids include retinol, retinoic acid or C₁-C₂₀ esters of retinol and retinoic acid (see column 4, lines 20-25 and 59-65 and column 5, lines 12-16, in particular.) Soares et al. teaches levels of retinoids in the compositions may be from 0.00001 to 2% (see column 4, lines 60-65, in particular), which is an amount that overlaps with that recited in claim 1. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the retinoid provided in the anti-acne or

anti-wrinkle composition, according to the guidance provided by Soares et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.) Soares et al. also exemplifies a sunscreen composition suitable for the two-composition product having a fragrance (see column 8, Table II, in particular.)

Accordingly, Soares et al. teaches providing an anti-wrinkle or anti-acne composition corresponding to the first composition as recited in claim 1, and teaches providing the first composition and a second composition (such as a sunscreen or cleanser composition) in first and second compartments isolate the compositions and that are also joined, as recited in claim 1.

Soares et al. does not specifically teach a second composition comprising the specific retinoid booster, such as citral, citronella, etc, as recited in claim 1. Soares et al. also does not specifically teach that the compartment having the retinoid keeps the retinoid composition out of contact with oxygen, as recited in claim 1.

Nakatsu et al. teaches a fragrance composition that can include non-aromatic terpenoid compounds such as citral, citronellol, geraniol and linalool, and that is suitable for various products (see abstract, and column 3, lines 25-45, in particular), and thus

teaches the retinoid boosters as recited in claim 1. Nakatsu et al. teaches that the fragrance composition can be included in a skin cream, hand and body lotion, sunscreen, and other compositions (see claim 9, in particular.) Thus, Nakatsu et al. teaches fragrances and fragrance compositions that are suitable for topical application to skin and can be used in topical formulations such as sunscreens.

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the fragrances and fragrance compositions of Nakatsu et al. in the compositions of Soares et al, and in particular in the sunscreen composition of Soares et al., because Soares et al. exemplifies such sunscreens have fragrances, and Nakatsu et al. teaches fragrances that are suitable for topical compositions such as sunscreens. Thus, one of ordinary skill in the art would have been motivated to provide the fragrances in the composition of Soares et al. with the expectation of providing a fragrance that is suitable for topical use and that is known to be suitable for combination with sunscreen compositions.

Regarding the amount of the fragrances provided, as recited in claim 1, it is noted that Nakatsu et al. teaches that the fragrance composition itself can comprise between 20 and 80% non-aromatic terpenoids, such as those claimed (see abstract, in particular), and Soares et al. exemplifies a composition having 0.30% of a fragrance (see Table II, in particular), which is an amount that meets the limitation of the claim. Accordingly, it is considered that one of ordinary skill in the art at the time the invention

was made would have found it obvious to vary and/or optimize the amount of the fragrance provided in the composition, according to the guidance provided by Nakatsu et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Accordingly, the teachings of Soares et al. and Nakatsu et al. render obvious a skin care product comprising first and second compartments for storing compositions, the compartments being joined, where the product comprises an anti-wrinkle cream having the retinoid first composition as claimed, and a sunscreen having the retinoid booster second composition (i.e. comprising fragrances), as recited in claim 1.

The combination of Soares et al. and Nakatsu et al. does not render obvious providing a compartment that keeps the retinoid composition out of contact with oxygen as recited in claim 1, such as a compartment made out of aluminum.

Liu et al. teaches that it is known that retinoids such as retinol, retinal and retinyl esters quickly lose their activity and oxidize in conventional skin care products (see column 2, lines 35-55, in particular). Liu et al. teaches that the oxidation of skin care compositions can be reduced by excluding oxygen permeation, particularly by fabricating the container walls from aluminum (see column 12, lines 40-68, in particular),

and thus teaches providing an aluminum container that keeps the retinoid composition out of contact with oxygen, as recited in claim 1, and thus also provides a "stable" skin care product.

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to modify the two compartment product teachings of Soares et al. to provide a compartment made of aluminum for the retinoid composition that keeps the retinoid out of contact with oxygen, because Soares et al. teaches the desirability of providing the two-compartment product to maximize the effectiveness of the separate compositions, and teaches providing retinoids in one of the compositions, while Liu et al. teaches that it is known that retinoids such as those taught by Suarez et al. can easily oxidize and lose their effectiveness, and that such oxidation can be reduced by providing aluminum containers. Thus, it is considered that one of ordinary skill in the art would have been motivated to provide the aluminum compartment to store the retinoid composition in the product of Soares et al, with the expectation of improving the effectiveness of the retinoid composition. Accordingly, claim 1 is obvious over the teachings of Soares et al. in view of Nakatsu et al. and further in view of Liu et al.

Regarding the recitation in claim 1 of "the first composition not being chemically degraded by the second composition and not coming into contact with the second compositions when being stored in the first compartment," it is noted, as discussed

above, that Soares et al. teaches the two compositions in the different compartments are kept separate because single formulations often compromise the performance of the severally combined actives (see column 1, lines 15-25, in particular.) Thus, it is considered that Soares et al. teaches that the compositions are isolated in each compartment so that the actives in each composition will not compromise the performance of one another, and thus teaches compartments in which the compositions are not degraded by each other and do not come in contact when being stored, as recited in claim 1.

Furthermore, regarding the recitations that "the first composition not being chemically degraded by the second composition and not coming into contact with the second compositions when being stored in the first compartment," and "the second composition potentiates the action of the retinoid upon contact," it is noted that as combined teachings of Soares et al, Nakatsu et al. and Liu et al. renders the claimed product and compositions obvious, the property of such a claimed product/compositions will also be rendered obvious by the prior art teachings, since the properties, namely the avoidance of degradation, lack of contact, and potentiation of action on contact, are inseparable from its composition. Therefore, if the prior art teaches the composition or renders the composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. The burden is shifted to Applicant to show that the

prior art product does not possess or render obvious the same properties as the instantly claimed product.

Regarding the recitation that the components of the second composition act are "retinoid boosters", as recited in the claims, it is noted that the retinoid boosting activity of a compound is a property thereof, and a product and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Accordingly, the composition rendered obvious by the combined references would, absent evidence to the contrary, meet the limitations pertaining to the retinoid boosting activity of the compound used therein.

Regarding claims 6 and 11, Soares et al, Nakatsu et al. and Liu et al. render obvious a product having first and second compartment that are joined together, and that isolate the compositions therein, the first composition keeping out oxygen and being made of aluminum, with a first composition having a retinoid as recited in the claims, and a second composition having a fragrance corresponding to the retinoid boosters as recited in the claims, as has been discussed above. While the references do not specifically teach providing the amount ranges of retinoid and retinoid booster as recited in the claims, the references do teach providing amounts that are close to and/or overlap with the amounts as recited. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of retinoids and/or fragrances provided in the composition,

according to the guidance provided by Soares et al., Nakatsu et al and Liu et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 2, 7 and 12, it is noted that Nakatsu et al. teaches the fragrances citral, citronellol and linalool, among others, may be provided in the composition, while the teachings of Soares et al. and Nakatsu et al. render obvious providing a fragrance composition in the amount as claimed, and thus the references teach that at least two fragrances (retinoid boosters) may be provided, as recited in the claims.

Regarding the methods of claims 4-5, 9-10 and 14-15, Soares et al. teaches that the retinoid may be a part of an anti-acne composition, and also acts as an anti-wrinkle agent (see column 4-5, in particular), and thus teaches providing the composition on skin for the treatment of acne and wrinkles. Soares et al. also teaches that the compositions can comprise emollients and humectants (see column 5, lines 35-40, in particular), which moisturize and condition the skin. Furthermore, as the combined teachings of Soares et al, Nakatsu et al. and Liu et al. renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the conditioning of skin upon

Art Unit: 1617

application, or the mimicking of the effect of retinoic acid such as the treatment of acne or wrinkles, upon application to skin, are inseparable from its composition. Therefore, if the prior art teaches the composition or renders the composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess or render obvious the same properties as the instantly claimed product. Thus, the methods as taught by Soares et al, Nakatsu et al. and Liu et al. necessarily result in skin conditioning, treatment of acne, wrinkles, etc, as recited in the claims.

Regarding claim 17, Soares et al. teaches that the composition can comprise an emollient such as esters of fatty acids and fatty acids (see column 5 line 35 through column 6, line 60, in particular), and thus teaches the emollients as claimed. Regarding the amounts of the emollients, Soares et al. teaches that the emollients can be provided as a part of the carrier, which can be in an amount of from 30 to 99.9% (see column 5, lines 35-42, in particular.) Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of emollient provided in the composition, according to the guidance provided by Soares et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

(2) Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,914,116 to Soares et al, issued June 22, 1999, in view of U.S Patent No. 5,965,518 to Nakatsu et al, published October 12, 1999, and further in view of U.S. Patent No. 5,976,555 to Liu et al, issued November 2, 1999, as applied to claims 1-2, 4-7, 9-12, 14-5 and 17 above, and further in view of JP 04183797 to Kobayashi et al, published June 30, 1992.

Suares et al, Nakatsu et al. and Liu et al, are applied as discussed for claims 1-2, 4-7, 9-12, 14-5 and 17 above, and render obvious the product having first and second compartment that are joined together and that isolate the compositions therein, the first composition keeping out oxygen, with a first composition having a retinoid as recited in the claims, and a second composition having a fragrance corresponding to the retinoid boosters as recited in the claims. Specifically, Soares et al, Nakatsu et al. and Liu et al. render obvious a product with anti-wrinkle composition having the retinoid, and a sunscreen composition having the fragrances (retinoid boosters), as recited in the claims.

The references do not specifically teach providing a retinoid booster that is alpha-ionone, as recited in claim 18.

Art Unit: 1617

Kobayashi et al. teaches compositions for formulation into cosmetics containing perfumes (see abstract, in particular.) Kobayashi et al. teaches that suitable perfumes for incorporation into cosmetics include ionone (alpha-ionone) (see Constitution section, in particular.)

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the ionone fragrance of Kobayashi et al. in the compositions of Soares et al, Nakatsu et al, and Liu et al, and in particular in the sunscreen composition of Soares et al, Nakatsu et al, and Liu et al, because Soares et al, Nakatsu et al, and Liu et al. teach such sunscreens having fragrances, and Kobayashi et al. teaches that ionone is a fragrance that is suitable for cosmetic formulations. Thus, one of ordinary skill in the art would have been motivated to provide the fragrances in the composition of Soares et al, Nakatsu et al, and Liu et al. with the expectation of providing a fragrance in the composition that is suitable for cosmetic use.

(3) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,914,116 to Soares et al, issued June 22, 1999, in view of U.S Patent No. 5,965,518 to Nakatsu et al, published October 12, 1999, and further in view of U.S. Patent No. 5,976,555 to Liu et al, issued November 2, 1999, as applied to claims 1-2, 4-7, 9-12, 14-5 and 17 above, and further in view of JP 04183797 to

Kobayashi et al, published June 30, 1992, and U.S. Patent No. 5,582,832 to Pillai et al, issued December 10, 1996.

Suares et al, Nakatsu et al. and Liu et al, are applied as discussed for claims 1-2, 4-7, 9-12, 14-5 and 17 above, and render obvious a product having first and second compartment that are joined together and that isolate the compositions therein, the first compartment keeping out oxygen, with a first composition having a retinoid as recited in the claims, and a second composition having a fragrance corresponding to the retinoid boosters as recited in the claims. Specifically, Suares et al, Nakatsu et al. and Liu et al. render obvious a product with anti-wrinkle composition having the retinoid, and a sunscreen composition having the fragrances (retinoid boosters), as recited in the claims.

The references do not specifically teach providing a retinoid booster that is climbazole in combination with a second retinoid booster selected from the groups consisting of alpha-ionone and damascenone, as recited in claim 16.

The teachings of Kobayashi et al. have been discussed for claim 18 above, and teach providing ionone as a fragrance in cosmetic compositions. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the ionone fragrance of Kobayashi et al. in the compositions of Suares et al, Nakatsu et al, and Liu et al, and in particular in the

sunscreen composition of Soares et al, Nakatsu et al, and Liu et al, because Soares et al, Nakatsu et al, and Liu et al. teach such sunscreens having fragrances, and Kobayashi et al. teaches that ionone is a fragrance that is suitable for cosmetic formulations. Thus, one of ordinary skill in the art would have been motivated to provide the fragrances in the composition of Soares et al, Nakatsu et al, and Liu et al. with the expectation of providing a fragrance in the composition that is suitable for cosmetic use.

Soares et al, Nakatsu et al, Liu et al. and Kobayashi et al. do not specifically teach providing climbazole in the composition, as recited in claim 16.

Pillai et al. teaches compositions for treating skin that contain an azole ingredient (see abstract, in particular.) Pillai et al. teaches that suitable azoles include climbazole (see column 4, lines 1-21, in particular), and further teaches that the azoles can be formulated into compositions including sunscreen compositions (see column 11, lines 34-55, in particular.) Pillai et al. even exemplifies a sun cream formulation comprising an azole (see Example 8, in particular.)

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the climbazole of Pillai et al. in the composition of Soares et al, Nakatsu et al, Liu et al. and Kobayashi et al, because Soares et al, Nakatsu et al, Liu et al. and Kobayashi et al. teach a product having a topical sunscreen formulation, and Pillai et al. teaches that azole compositions having

azoles such as climbazole can be formulation into sunscreens. Thus, one of ordinary skill would have been motivated to provide the climbazole in the sunscreen composition of Soares et al, Nakatsu et al, Liu et al, and Kobayashi et al, with the expectation of providing a suitable ingredient for the sunscreen formulation.

Response to Arguments

35 U.S.C. 112, first paragraph

The Examiner agrees with the Applicant's arguments to withdraw the 35 U.S.C. 112, first paragraph rejection because on page 30, lines 15-22 of the specification states that the dual compartment package may be designed in various ways known to persons of ordinary skill in the art as long as the purpose of providing the first and second composition in two separate containers is achieved and the compositions are retained separately. The Examiner believes that the above disclosure reads on when the composition is in storage.

35 U.S.C. 103(a) rejections

Applicant's arguments regarding the rejections of the claims have been fully considered but they are not persuasive.

The Applicant argues that the Examiner has admitted that the combination of the teachings of the '116 reference and the '518 reference does not render the claimed invention obvious since it does not describe providing a compartment that keeps retinoid containing compositions out of contact with oxygen. Contrary to the presently claimed invention, nothing in the '116 reference even remotely suggests a stable skin care product that has two compositions that are isolated from each other in different compartment prior to use. As set forth in independent claim 1, as amended, the second composition potentiates the action of retinoid upon contact with the first composition. Nowhere in the '116 reference is such a product even remotely suggested. The same is true and required of the stable skin care products described in independent claims 6 and 11 as presented herein.

The Examiner disagrees because the Examiner has clearly pointed out what '116 and '518 do not teach, but does not state that the references do not render the claimed invention obvious. The references '116 and '518 render the claimed invention obvious in combination with '555. Particularly, '116 teaches a stable skin care product that has two compositions that are isolated from each other in different compartments prior to use in the abstract and column 2; lines 1-14. More particularly, '116 teaches that the two compositions are kept separate because single formulation often compromise the performance of the severally combined actives (see abstract and column 2; lines 1-14). In regards to the property exhibited when the second composition comes in contact with the first composition, this property is inherently taught by the combined teachings of '116 and '518. The reference '116 teaches that the first composition can be a sunscreen and the second composition is an anti-wrinkle cream (see Table 1, tenth entry). The anti-wrinkle compositions contain retinoids active ingredients such as retinol, retinoic acid or C₁-C₂₀ esters of retinol and retinoic acid (see column 4, lines 20-25 and 59-65 and column 5, lines 12-16). Lastly, '116 teaches that the sunscreen

composition has fragrances (see column 8, Table II). The reference '518 provides the teaching that common fragrances that are used in various products such as skin cream, hand and body lotion, sunscreen and other compositions include citral, citronellol, geraniol and linalool (see abstract; column 3, lines 25-45; and claim 9). Thus, the combined references teach the applicant's compositions. Upon the same two compositions coming in contact with one another, they will inherently have the same reaction. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. Thus, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). "Products of identical chemical composition can not have mutually exclusive properties." Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F. 2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden is shifted to Applicant to show that the prior art product does not possess or render obvious the same properties as the instantly claimed product. Additionally, the reference '116 teaches that the two compositions are separated because single formulations often compromise the performance of the severally combined actives (see abstract and column 2; lines 1-14). Thus, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences

would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The Applicant argues that none of the vast deficiencies of the primary references, namely the '116 reference are even remotely cured by the '518 reference since the '581 reference only discloses fragrance composition having antimicrobial activity. Turning to the '555 reference, the same only shows topical water-in-oil emulsions with retinoids.

The Examiner disagrees because the teachings of the '518 and its relevance is discussed above in regards to the fragrance. Additionally, other compositions that contain the applicant's "retinoid boosters", which also have the property of being a fragrance as disclosed in '518 are various products such as skin cream, hand and body lotion, sunscreen and other compositions (see claim 9). In regards to the '555 reference teaching only topical water-in-oil emulsions with retinoids, the claims are not limited to the type of topical retinoid (i.e. water-in-oil emulsions versus cream), but that the product comprises a retinoid to be used as a skin care product. Second, the '555 reference provides the teaching that retinoids quickly lose their activity and oxidize in conventional skin care products (see column 2, lines 35-55). Third, the reference provides teachings that the oxidation of skin care compositions can be reduced by excluding oxygen permeation, particularly by fabricating the container walls from aluminum (see column 12, lines 40-68). Thus, '555 provides motivation for one skilled in the art to keep the first composition that comprises a retinoid out of contact with

oxygen (the limitations of Applicant's claims 1, 6 and 11) and that the compartment comprise aluminum (the limitation of Applicant's claim 11).

The Applicant argues that the deficiencies of the references relied on by the Examiner are not cured by the '797 reference since the same merely describes ionone perfumes in compositions like cosmetics and solid soaps. The Applicant further argues that the '832 reference merely describes the use of climazole formulated into compositions with sunscreen, the '832 reference does not cure any of the vast deficiencies of the prior references relied on by the Examiner.

The Examiner disagrees because the relationship between perfumes and the compositions of '115 and '581 have been discussed above. Particularly, the sunscreen compositions of '115 comprise fragrances. Thus, the '797 reference provides the teaching of the particular fragrance ionone which can also be used in cosmetics. Since the composition of '115 is also a cosmetic, one skilled in the art would find it obvious to use the fragrance of '797 because the fragrance has been shown to be used in other topical skin cosmetic compositions. The same argument applies to the '832 reference. More particularly, '832 provides teachings of a fragrance used in a sunscreen. Thus, one skilled in the art would find it obvious to use the fragrance of '832 because the fragrance has been shown to be used in other sunscreen compositions.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kendra D. Carter whose

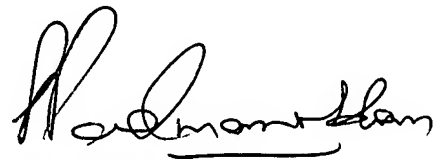
Art Unit: 1617

telephone number is (571) 272-9034. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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KDC

A handwritten signature in black ink, appearing to read 'S. Padmanabhan', with a horizontal line underneath the name.

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER